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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,096	04/01/2005	Masashi Kudo	121036-0078	5558

7590

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/530,096

Applicant(s)

KUDO ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/30/06 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10, 15-19 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 2-10, 15-18, 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Applicants' amendment filed on August 30, 2006 is acknowledged.

Claims 1, 11-14, 20-31 and 33 deleted. Claims 2-5, 7-10, 15-18 and 32 amended.

Now, Claims 2-10, 15-19 and 32 are pending.

2. Claim rejection(s) under 35 USC 103 in paragraph 10 of the previous Office Action (Paper No. 052706) is/are removed.

3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

#### ***Claim Objections***

4. Claim 15 is objected to because of the following informalities:

In Claim 15 (last line), should "harnesses" be removed?

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1712

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-5, 7-9, 15-18 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 2-5, it is not clear as to what Applicants intend to claim, i.e., a sealing material or an automobile engine cam cover.

In Claims 7-9, it is not clear as to what Applicant intend to claim, i.e., a sealing material or an automobile engine oil pan.

In Claims 15-18 and 32, it is not clear as to what Applicants intending to claim, i.e., a sealing material or an automobile wire harness.

### ***Double Patenting***

7. Double patenting rejection of Claims 2-5, 7-9 and 15-18 is maintained because the rejection is adequately set forth in paragraph 4 of Paper No. 052706. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

In view of the rejection set forth in the previous paragraph, the double patenting rejection is maintained.

For Applicants' argument (Remarks, page 11, paragraphs 1-6), note that both the present invention and that of the copending Application claim materials. Note that "for vibration-absorbable mounts" in the copending Application is merely an intended use. In addition, unless Applicants can show otherwise, the present invention does not exclude the possibility of the material having the characteristics of the material in the copending Application.

***Claim Rejections - 35 USC § 102 and 103***

8. Rejection of Claims 2-9 and 15-17 under 35 USC 102(b) as being anticipated by JP255 (JP 2000-154255) is maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 052706. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 11, last paragraph to page 12, paragraph 4), in view of the rejection set forth in the paragraph 6, the instant rejection is maintained.

9. Rejection of Claims 18 and 32 under 35 USC 103(a) as being unpatentable over JP255 is maintained because the rejection is adequately set forth in paragraph

Art Unit: 1712

8 of Paper No. 052706. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 12, paragraph 5), in view of the rejection set forth in the paragraph 6, the instant rejection is maintained.

10. Rejection of Claim 10 under 35 USC 103(a) as being unpatentable over Lopez (US 4 394 853) in view of JP255 is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 052706.

For Applicants' argument (Remarks, page 12, 1<sup>st</sup> paragraph), note that the rejection is clearly described in Paper No. 052706, supra.

***Allowable Subject Matter***

11. Claim 19 is allowed.

12. The following is an examiner's statement of reasons for allowance:

JP255 does not teach or fairly suggest an automobile wire harness sealed by a sealing material set forth in the instant claim.

Art Unit: 1712

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on

Art Unit: 1712

(571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

November 8, 2006

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712